

REMARKS/ARGUMENTS

In the Official Action, restriction is required as between allegedly patentably distinct species of the claimed invention (see, Office Action, page 2, lines 7-8). The embodiments listed are: Embodiment 1: figure 1; Embodiment 2: figure 2; and Embodiment 3: figure 3. As a very first matter, this restriction requirement is improper in its form, composition, and lack of substance.

There is no presentation of a reason in the Office Action why each of the "Embodiments" are being restricted.

This restriction requirement is respectfully traversed.

Election of Species Under Traverse

In response, as a formality merely to comply with §818.03(b), Applicants hereby preliminarily elect figure 1, designated as Embodiment 1, for an examination on the merits. While this present Office Action recognizes that Claim 1 is generic to each of the listed embodiments (see, Office Action, page 2, line 14), it fails to recognize that Claims 2, 5, 6, 8, 9, 10, 11, 12, 13, 14 are also generic to each of the three listed embodiments. Claims 3, 4, and 7 appear to read on Embodiments 1 and 2, although the Applicants respectfully reserve the right to introduce

additional arguments in support of Claims 3, 4, and 7 reading on Embodiment 3 in the future should the Restriction requirement be finally upheld.

Arguments in Support of Traversal of Restriction

As a first point, the Office Action has not given any reason why the supposed "species" are considered to be patentably distinct. Without any supporting reasons, it is not Applicants' burden to show they are not distinct. Likewise it is not incumbent upon Applicants to admit that subgroups of claims are obvious variants of other groups of claims. The features are not obvious unless the Office Action cites prior art showing that dependent features are obvious in view of the cited prior art.

As stated in the Amendment/Election of Species with traverse previously submitted on May 2, 2005, it is Applicants' position that in fact each of the claims are drawn essentially to a single device claiming the same essential features and are not drawn to separate species. This fact should be clear merely from the claims themselves that are all submitted as dependent on Claim 1. Each of the claims in fact are drawn to a "control element having a rotary knob ..."

While 35 U.S.C. 121 states that "[i]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." This section provides no guidance on what "independent and distinct" means.

The MPEP in 806.01, entitled "Compare Claimed Subject Matter" makes clear that (emphasis provided) "[i]n passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.

Further, MPEP §802.01 (emphasis provided), entitled "Meaning of 'Independent' and 'Distinct' provides guidance as to the meaning of "independent and distinct" as used in 35 U.S.C. §121 and in 37 CFR 1.141. This in fact is the question as to when it is proper for the Commissioner to require restriction. The MPEP as a first matter states the obvious that "independent", of course, means not dependent. The MPEP further states that the "term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for

example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process." Clearly restriction is not proper in this case where each of Claims 2-14 are written in dependent form of Claim 1 and are directed to a control element having a rotary knob.

The MPEP states that the "term 'distinct' means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed. While this guidance in interpretation for the term "distinct" may seem to provide free rein for restriction, this in fact is not the case.

The MPEP in §806.03 makes clear that (emphasis provided) "[w]here the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required." The MPEP goes on further to state the motivation for the above requirement is "because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition."

MPEP §806.04 provides examples of when restriction is proper:

806.04 Independent Inventions

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one of such independent inventions. For example:

(A) Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

(C) Where species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

The MPEP in §803 makes clear that a restriction between patentably distinct inventions is only proper if the inventions are independent or distinct as claimed and there is a serious burden on the examiner if a restriction is not required. A serious burden on the examiner is prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search (see, further MPEP §808.02). However, where "the

classification is the same and the field of search is the same and
there is no clear indication of separate future classification and
field of search, no reasons exist for dividing among related
inventions." Yet, the Office Action has done no more than to
state that they are separate and distinct without any showing or
explanation for this distinction.

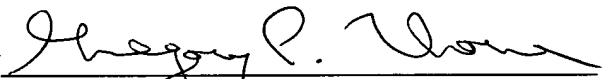
There is no attempt in the Office Action to provide reasons
why restriction is required. There is no showing of a separate
classification, separate field of search, or any showing of
additional burden on the Examiner for searching and examining the
claims together in one patent application. Clearly none of the
above examples are applicable in the case wherein each claim is
drawn to a control element having a rotary knob.

Accordingly, it is respectfully submitted that restriction is
improper. It is therefore respectfully requested that the
restriction requirement be withdrawn and that the claims be
examined on the merits.

In the event that this restriction requirement is upheld, it is respectfully requested that it be restated in a non-final form with support for the requirement (e.g., such as an explanation of the additional burden on the Examiner) so that the Applicants may address that support in a subsequent response.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

By 
Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
August 23, 2005

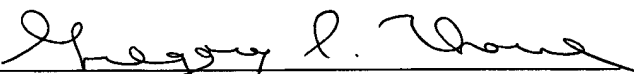
THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101

CERTIFICATE OF MAILING

It is hereby certified that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to:

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

On August 23, 2005
(Date of Mailing)

By 
Mailing Party